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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,003	01/16/2002	Maria Azua Himmel	AUS920010811US1	6343

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EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,003

Applicant(s)

HIMMEL ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-34 are presented for examination. Claim 34 is newly added.
2. It is noted that the status of claim 18 appears to be erroneous because no changes are found in the claim languages even though the status is marked as "currently amended".
3. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

Claim Rejections - 35 USC § 103

4. Claims 1-2, 5-15, 18-19, 22-30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669].
5. Rossmann was cited in the previous office action.
6. As to claims 1-2, Rossmann teaches the invention substantially as claimed including: a method of automatically capturing identified data elements such as addresses and telephone numbers from emails or web pages and store it into the email recipient's (i.e., remote user device or terminal) local address or telephone directory [see e.g., Abstract and paragraphs 45 and

55-58; note that at claims 13-17, Rossmann further teaches that a user's website is treated as user terminal].

Rossmann does not specifically teach entering at least one telephone number into a browser and send the number to at least one destination address that is associated with a remote user device, wherein the destination address is entered into the browser.

However, it is well known in the art that a user who uses Internet provider's mail services (such as hotmail.com or aol.com) may send email messages to anywhere reachable by the Internet. Additionally, it is also well known a web page may provide automatic emailing mechanism with a "send information to a friend" button or the like, wherein the web page may contain advertised information including telephone numbers.

As such, it would have been obvious to one of ordinary skill in the art that a user of Internet provider's mail services may send information of interest such as telephone numbers and automatically send it to remote email recipients after entering their email addresses into an email editor (which is provided through a web browser), or alternatively using the browser's bookmark to record the email address (which may be associated with a website), and cause the email to be automatically sent over the internet to destination addresses that are associated with the remote users' devices or website because these functions have long been provided to the Internet surfers.

7. As to claims 5-6, Rossmann further teaches that the communications terminal is selected from a mobile telephone, a personal computer, a voice mail messaging service, a FAX machine, a handheld computer, a personal digital assistant or combinations thereof, wherein the

communications terminal is selected from a device that can store and retrieve information and is connectable to a telephone network [e.g., 301, Fig.3 or 400, Fig.4].

8. As to claim 7, Rossmann further teaches that each destination address is selected from the group consisting of a computer network address, Internet address, and telephone number [e.g., paragraphs 15 and 33-34; i.e., inherently the wireless device must be provided with a network address of ID for communicating with other servers in the network].

9. As to claims 8-9, Rossmann further teaches that the one or more telephone number records comprises a telephone number and an alphanumeric identifier for the telephone number, wherein the telephone number record comprises parameters selected from a telephone number, a contact name, an address, a FAX number, an e-mail address, a hyperlink to a Web site, a business name, a business specialty, business hours or combinations thereof. [paragraph 68; i.e., a telephone number can be associated with the person's name and other attributes].

10. As to claim 10, Rossmann does not specifically teach the entering steps as described in steps d-f. However, based on the example mentioned in the rejection of claim 1, it is obvious that a subscriber of the email service provider follows the same procedure to use an email composing tool, which is provided through the browser, to select an email address on an interactive display (note that the email addresses are also stored locally through the browser) because this is exactly what's been provided as part of the email service.

11. As to claim 11, Rossmann further teaches that the telephone numbers can be captured from a web page [Abstract].

12. As to claim 12, Rossmann teaches that the method further comprises: repeating steps (d) and (e) to enter additional telephone number records [note that this step are inherent in Rossmann's method because each additional telephone number record is undergoing the same procedure performed by the browser/sever software].

13. As to claim 13, Rossmann further teaches that the telephone number record comprises a telephone number and an alphanumeric identifier for the telephone number [e.g., the telephone owner name], the method further comprising:

Rossmann does not specifically teach that the modifying makes the telephone number compatible with the communication terminal's telephone system and displayed in a standard format suitable for a format of the electronic telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to edit the telephone number compatible with Rossmann communication terminal (which is a cellular phone) and displayed in accordance with the PIM or telephone book format because by doing so the stored phone numbers can be made directly usable as they are stored.

14. As to claims 14-15, Rossmann does not specifically teach the step of sending the at least one telephone number record as described.

However, as mentioned in the rejection of claim 1, it is an obvious feature because a subscriber of the email service provider follows the similar procedure can enter an email address and send an email message to an intended recipient, wherein it is an option (i.e., design choice) to mark the message (e.g., by entering in the subject of the email that a telephone record is contained in the mail.

15. As to claims 18-19, 22-30 and 33-34, since the features of these claims can also be found in claims 1-2, 5-11 and 13-15, they are rejected for the same reasons set forth in the rejection of claims 1-2, 5-11 and 13-15 above.

16. Claims 3-4, 16-17, 20-21 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669], as applied to claims 1-2, 5-15, 18-19, 22-30 and 33 above, further in view of Official Notice

17. As to claim 3, Rossmann does not specifically teach the steps of:

d. determining if each telephone number record already exists in the electronic telephone directory, wherein each telephone number record includes a telephone number and an alphanumeric reference;

e. recording each telephone number record into the electronic telephone directory if the telephone number and alphanumeric reference do not already exist in the electronic telephone directory; and

f. providing notification to a user device if the at least one telephone record contains any telephone number or alphanumeric reference that already exists in the electronic telephone directory.

However, Official Notice is taken that this additional feature is well known in the art. For example, a user is warned when an attempt to overwriting a record of a file is made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to follow this conventional procedure to update Rossmann telephone directory because the procedure ensures the integrity of the directory.

18. As to claim 4, Rossmann does not specifically teach how a telephone record in the telephone directory is updated (e.g., deleting, adding, or modifying a record). However, Official Notice is taken that the listed feature is typical procedure in updating a database or telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adopt the conventional database updating procedure in updating Rossmann's system/method because such procedure ensures the integrity of Rossmann telephone directory.

19. As to claims 16-17, Rossmann teaches that the message containing at least one telephone number may be sent to a website (which is regarded as a user's terminal) [see the rejection of claim 1]. Rossmann does not specifically teach marking the message with a password, wherein the password is recorded into the web browser.

However, Official Notice is taken that marking a message with secret code or password for security purpose or for filtering unrelated email messages is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to mark Rossmann's email messages that is intended for automatic telephone extraction at the receiving end, because by doing so it would properly filter out all unrelated emails from the extraction.

Further, Official Notice is taken that it is well known the browser is capable of remembering a user's password as an option (e.g., not having to remember or type the password each a user signs on the Internet). It would have been obvious to one of ordinary skill in the art at the time the invention was made that an Internet user may exercise such an option by allowing the browser to remember the password because its convenience may out-weight the privacy.

20. As to claims 20-21 and 31-32, since the features of these claims can also be found in claims 1, 3-4 and 16-18, they are rejected for the same reasons set forth in the rejection of claims 1, 3-4 and 16-18 above.

21. Applicant's arguments filed on 7/8/2005 for claims 1-33 have been fully considered but they are not deemed to be persuasive.

22. Applicant argues in the remarks that:

1. The destination addresses in Applicant's claims were saved and entered into the browser, which is not same as what the examiner proposed.

2. Applicant further amended claim 18 to show that the telephone records are automatically sent, which further deviates from the examiner's proposed scenario where email addresses need to be manually entered and sent by the user.
 3. The examiner provides no motivation why one would combine emailing technology for automatically sending an email containing telephone number records to remote terminals so that these records may be entered into electronic telephone directory.
 4. Applicant rebuts the examiner's taking Official Notices and traverse the statement that the limitation in claims 3-4 and 20-21 are well-known in the art of the claimed invention.
23. Examiner respectfully disagrees with applicant's remarks:
1. As to point 1: Applicant is reminded that the claim languages does not require saving the destination addresses into the browser. On the other hand, the previous office action did mention an alternative that the destination addresses could have been saved into the browser's bookmark (see paragraph 8 on page 5 of the previous office action) wherein the remote user's terminal was regarded as another website.
 2. As to points 2 and 3: it is noted that claim 18 has not been amended to include the "automatic sending" feature; claim 2 does. In response to this newly added feature, the examiner argues that the current email system already has the capability of automatically sending messages to a destined party (after the sender's address is provided). The examiner further uses the well-known "send this information to a friend" button as an example of automatic sending capability. If Applicant desires to automate the entry of telephone records and the destination addresses, such features should be explicitly shown

in the claim languages. Note that the motivation in the 103 rejection of the pre-amended claim 2 was embedded in the reasoning process because the listed examples are known browser functions provided to Internet users. For clarification in this office action, the same motivation has been explicitly stated.

3. As to point 4: The previous Official Notices are maintained in this office action because Applicant merely disagrees with the examiner's reasoning about well-known facts without specifically pointing out the supposed errors and/or requesting for evidentiary support.

"To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.")."

[See MPEP 2144.03(c)]

For at least the above reasons, it is submitted that the prior art of record reads on the claims.

24. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571)273-8300 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

December 1, 2005

Wen-Tai Lin
12/1/05